

REMARKS

Applicant has carefully reviewed the Office Action dated September 12, 2005. Claims 1-16, 18-33 and 35 are pending in this application. Although the claims have not been amended in the present Response, Applicant has provided a listing of the claims for the Examiner's convenience. Reconsideration and favorable action is respectfully requested.

Claim rejections in view of obviousness under 3 U.S.C. § 103

As stated by the Federal Circuit in *Cardiac Pacemakers, Inc. v. Guidant Sales Corp.*, 381 F.3d 1371, 1376 (Fed. Cir. 2004), "[w]hen prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself." Moreover, the Federal Circuit has recently stated that "[a]s this court outlined in *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004), in making the assessment of differences between the prior art and the claimed subject matter, section 103 specifically requires consideration of the claimed invention 'as a whole.' Inventions typically are new combinations of existing principles or features.... The 'as a whole' instruction in title 35 prevents evaluation of the invention part by part. *Ruiz*, 357 F.3d at 1275. Without this important requirement, an obviousness assessment might successfully break an invention into its component parts, then find a prior art reference corresponding to each component. *Id.* This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components. Further, this improper method would discount the value of combining various existing features or principles in a new way to achieve a new result-often the essence of invention. *Id.*" *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1337 (Fed. Cir. 2005).

Applicant submits that the Examiner has taken the approach specifically forbidden by the Federal Circuit in *Princeton Biochemicals* and has simply broken Applicant's invention into its component parts, and then attempted to find a prior art reference corresponding to each component. As such, Applicant submits that support for the combination is based on hindsight and the combination is therefore improper.

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As will be discussed below in greater detail with respect to specific paragraphs of the Office Action, the motivation provided by the Examiner fails to meet the required standard. As a preliminary matter, Applicant notes that the Examiner relies on *In re Fine* and *In re Jones* and, while both are valid cases, they are also eighteen and fourteen years old, respectively. Applicant has presented two recent cases (*Cardiac Pacemakers* and *Princeton Biochemicals*) where the Federal Circuit has elaborated on the standard required. For example, *Princeton Biochemicals* reiterates the established principle that care must be taken in order to avoid the use of hindsight to "prevent[] evaluation of the invention part by part."

For convenience, the numbering of the following paragraphs corresponds to the numbering of the paragraphs of the Final Office Action dated September 12, 2005. However, for purposes of clarity, Applicant is not repeating all of Applicant's previous arguments. Accordingly, while some paragraphs have been omitted in order to focus the present Response on specific issues, Applicant is not waiving the right to assert previous arguments for purposes of Appeal. In addition, some paragraphs from the Office Action are not addressed directly, but Applicant has included them in the present Response in order to add context to following paragraphs.

9. The Office action states that "regarding claim 1, Hudetz disclosed a method of displaying a web page to a user (Figure 6, column 8 lines 17-20) comprising the steps of retrieving location information associated with the unique code from a database, the location information corresponding to a location of the web page on a remote location disposed on the network (Figure 4, column 9 lines 59-62, column 11 lines 33-60); in response to retrieving the location information, connecting the activation system to the remote location (column 11 lines 28-37); and presenting the web page corresponding to the location information of the remote location to the user via the activation system (Figure 6, column 9 lines 54-62)."

Applicant has addressed this in previous Responses and, for purposes of brevity, simply notes that Applicant continues to maintain that the Examiner has not established a prima facie case of obviousness as required by both the MPEP and case law.

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Further, the Examiner has correctly admitted that the term "automatically" with respect to the step of connecting is not taught or suggested in Hudetz. However, the Examiner indicates with the language of paragraph 9 that Hudetz connects the "activation" system to a remote location. The Examiner's use of the term "activation" is not supported in Hudetz. All Hudetz does is to allow a user to, under control of the user, activate a scanner and move the scanner across a bar code. Thus, the "activation" system is not disclosed in Hudetz.

10. The Office action states that "Hudetz taught the invention *substantially* as claimed. However, Hudetz did not expressly disclose a method of providing a portable triggering device having a unique code stored therein and extracting the unique code from the triggering device with an activation system when the portable triggering device is proximate to the activation system, the activation system disposed on a network and physically separates from the triggering device." (Emphasis added)

Applicant submits that Hudetz cannot teach the invention substantially as claimed, as the Examiner has admitted that Hudetz fails to disclose "a method of providing a portable triggering device having a unique code stored therein and extracting the unique code from the triggering device with an activation system when the portable triggering device is proximate to the activation system, the activation system disposed on a network and physically separates from the triggering device," as well as "automatically" (paragraph 14).

11. The Office action states that "Hudetz suggested exploration of art and/or provided a reason to modify the method with the portable triggering device feature (Figure 8, column 6 lines 28-33, column 7 lines 17-28, column 12 lines 11-21)." Applicant respectfully traverses this statement for the following reasons.

Col. 6, lines 28-33, are reproduced below, as are lines 34-67.

UPC symbol 46 provides a machine-readable number that uniquely identifies a particular product and its manufacturer. This is useful at the retail point-of-sale, where purchase of a particular item is recorded by scanning the item's bar code symbol. (col. 6,

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lines 28-33)

There are numerous other formats and systems for assigning product identification numbers to articles of commerce. For example, the International Article Numbering Association ("EAN") assigns its own number to products outside of the U.S. and Canada, and uses a different symbology than used with the UPC. Product identification codes for books are provided by the International Standard Book Numbering System ("ISBN") and are encoded using a symbology specified by that organization. Likewise, magazines and serial publications are assigned product identification codes by the International Standard Serial Numbering System ("ISSN").

These numbering systems share at least three characteristics. First, for purposes of this invention, the identification numbers may be assigned in accordance with an "extrinsic" standard. By extrinsic, it is meant that the assignment of numbers is made by a group or association for the purpose of identifying articles of commerce. It is likely that new types of identification numbers will arise in the future, as will new organizations for assigning and administering those numbers, and the present invention contemplates use of both existing and future extrinsic identification numbers and formats.

Second, the identification numbers may have recognized significance as numbers identifying articles of commerce. The level of recognition may be among the general public, or a defined subset, such as a particular industry or occupation.

Third, the identification numbers may be encoded in a standard, machine readable format--namely, bar codes. Other machine readable formats may also be used for this purpose, including magnetic stripes or optical character recognition ("OCR"), and the present invention could be practiced with product identification numbers encoded in those formats as well. (col. 6, lines 34-67)

Applicant can find no indication in the preceding text that Hudetz has "suggested exploration of art and/or provided a reason to modify the method with the portable triggering device feature" as claimed by the Examiner. The text is simply describing the use of identification codes that have three characteristics, and the fact that Hudetz requires such codes. While the cited text does refer to the use of other codes, it appears that alternate codes must have the three

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characteristics identified by Hudetz. Although not discussed in detail here, the codes described in both Nelson (a personnel ID code) and Russell (an encoded URL) do not have the three characteristics required by Hudetz. Accordingly, not only can Applicant find no teaching or suggestion for a combination in the cited text as asserted by the Examiner, but the teaching of Hudetz is contrary to that of Nelson and Russell.

The text of col. 7, lines 17-28, is reproduced below.

Each record 62-68 of database 60 associates a UPC product identification number (contained in fields 70 and 72) with a particular Internet URL and narrative description (contained in fields 74 and 76, respectively). The association is based on selected criteria. In this case, the criteria is the existence of a Web resource sponsored by the manufacturer of the product identified by the UPC number in fields 70 and 72. (If no such resource exists, then the particular product identifier can be omitted from database 60). Other criteria can be used. For example, the association could be based on the existence of a Web site simply referring to or relating to the product.

Again, Applicant can find no indication in the preceding text that Hudetz has "suggested exploration of art and/or provided a reason to modify the method with the portable triggering device feature" as claimed by the Examiner. The text simply states that various association criteria can be used so that "[e]ach record 62-68 of database 60 associates a UPC product identification number (contained in fields 70 and 72) with a particular Internet URL and narrative description (contained in fields 74 and 76, respectively)."

The text of col. 12, lines 11-21, is reproduced below.

The foregoing embodiment is just one example. Many alternatives are possible. For example, in lieu of a bar code scanning device, a card reader could be employed. The card reader would read a magnetic stripe affixed to a card or other printed matter. The card would contain human-readable information about a network resource, and the magnetic strip would contain the resource's numeric or mnemonic address in machine-readable format. Alternatively, a RF data collection scanner or CCD scanning system could be used. Bar code symbol 126 could also be associated with specific commands such as

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"forward", or "back," or command sequences used to access information.

While the preceding text states that various devices, including a card reader, a RF data collection scanner, and a CCD scanning system may be used in Hudetz, it fails to actually provide any detail whatsoever regarding such embodiments. Moreover, it is unclear as to what structure or functionality such devices have and certainly does not suggest a reason for combining one or more of the devices with another reference. In fact, the cited text makes no reference to the desirability of either a portable device or a triggering device. Accordingly, it is difficult to understand how such a vague statement would have "suggested exploration of art and/or provided a reason to modify the method with the portable triggering device feature" in the particular manner claimed by the Examiner.

12. The Office action states that "[i]n an analogous art, Nelson disclosed a method of providing a portable triggering device having a unique code stored therein (Abstract, column 3 lines 10-13, column 5 lines 42-50) and extracting the unique code from the triggering device with an activation system when the portable triggering device is proximate to the activation system (column 1 lines 40-47, lines 56-61, column 3 lines 10-13, column 6 lines 8-25), the activation system disposed on a network and physically separates from the triggering device (column 3 lines 10-13, column 11 lines 9-12)."

13. The Office Action states that "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Hudetz with the teachings of Nelson to include the portable triggering device in order to offer users a more automatic method in obtaining the identification code using the interrogator unit and the triggering device (Nelson, column 6 lines 8-21) since this would allow users to access published locations without having to manually enter the published address through input devices (Hudetz, column 2 lines 53-55)."

The text of col. 6, lines 8-21, of Nelson is reproduced below.

The identification code stored in the memory of transponder 22 becomes associated with a particular code recipient when patch

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20 is adhered to that code recipient. Thereafter, the memory of transponder 22 can be remotely read using an interrogator unit in order to determine the identification code previously associated with the code recipient. This procedure is schematically shown in FIG. 3. Referring to FIG. 3, a code recipient 30 carries patch 32 containing a transponder 34. In order to determine information comprising the identification code stored in transponder 34 and associated with the code recipient 30, interrogator unit 36 transmits an interrogation signal 38 to transponder 34. After receiving and processing the interrogation signal 38, transponder 34 transmits response signal 40 back to the interrogation unit 36.

The preceding text of Nelson simply describes the invention of Nelson, and Applicant can find no teaching or suggestion in the cited text of modifying Hudetz with Nelson.

The text of col. 2, lines 52-55, of Hudetz is reproduced below, as is the remainder of the paragraph (lines 55-67) that is not cited by the Examiner. Also reproduced is the paragraph of col. 3, lines 1-13, which immediately follows the paragraph cited in the Office Action.

In our copending application, we proposed to resolve these problems by allowing people to access published locations without having to manually enter the published address. (col. 2, lines 53-55)

In accordance with one embodiment of the invention, disclosed in our court pending application the mnemonic address or verbal description of a network location is published along with the location's numeric address in bar code format. The user's computer is equipped with a bar code reader and browser software. The bar code reader is suitably interfaced to the computer's browser software to allow bar code input to be accepted as address information. When the user sees an interesting published address, he scans the associated bar code using the bar code reader, thereby loading the desired numeric address into the browser. The browser then accesses the Web or other site corresponding to that numeric address. (col. 2, lines 55-67)

We are finding several problems with this and other approaches that have been tried. First, some URLs and other network addresses contain upwards of 20-30 characters, and therefore require very long bar code symbols, which can clutter advertising and packages, and may not be practical from either an esthetic or technical perspective. Second, placing URLs on printed material

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(whether or not in bar code format) requires manufacturers to redesign products, packaging and/or advertisements, and many manufacturers may be reluctant to do this. Third, previous proposal, if the network address is changed, the package needs to be redesigned, and packages already in the marketplace will have incorrect address information. (col. 3, lines 1-13)

Even assuming, for purposes of argument, that a broad reading of the initial sentence (lines 53-55) lends some credence to the Examiner's contention of a suggestion for modifying Hudetz with Nelson, the remaining portion of the paragraph undermines such a broad reading. As required by MPEP § 2141.02(VI), "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention."

Applicant submits that the Office Action's selective recital of a portion of the paragraph above ignores the portion that leads away from the claimed invention. More specifically, the proposal "to resolve these problems by allowing people to access published locations without having to manually enter the published address" is then addressed by publishing "the mnemonic address or verbal description of a network location ... along with the location's numeric address in bar code format.... When the user sees an interesting published address, he scans the associated bar code using the bar code reader, thereby loading the desired numeric address into the browser." The following paragraph (col. 3, lines 1-13) then describes some problems with this approach. This leads to the present application of Hudetz which:

offers a better way for consumers and others to access resources on remote computers, particularly Web sites. In accordance with one aspect of the invention, the dissemination and entry of network addresses is accomplished by means of existing identification standards (e.g., bar codes) found on ordinary products like soup or soda, in conjunction with a centralized database of network locations. (col. 3, lines 17-19)

Accordingly, the proposal "to resolve these problems by allowing people to access published locations without having to manually enter the published address" does not support the combination of Hudetz and Nelson, but directs the reader to the solution presented throughout Hudetz. The Examiner's broad reading of this single sentence out of context (e.g., by ignoring the remainder of paragraph) violates the standard imposed by MPEP § 2141.02(VI) that a prior art reference must be considered in its entirety. Applicant submits that, when the single

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sentence cited in the Office Action is read in context, it fails to provide any suggestion for combining Hudetz and Nelson. In fact, one skilled in the art would have no motivation to combine Hudetz with Nelson, as Hudetz claims to provide a solution to the problem it presents.

14. The Office Action states that "[t]he combination of Hudetz and Nelson taught the invention substantially as claimed. However, the combination of Hudetz and Nelson did not teach in response to retrieving the location information, *automatically* connecting the activation system to the remote location."

15. The Office Action states that "Hudetz suggested exploration of art and/or provided a reason to modify the method with the automatic connection with the remote location (column 2 lines 52-67)."

As stated with respect to paragraph 13, Applicant submits that the cited text of Hudetz is not suggesting exploration of art and/or providing a reason to modify the method as Hudetz claims to provide a solution. In fact, Hudetz actually teaches away from the encoded URLs disclosed by Russell, as Hudetz:

offers a better way for consumers and others to access resources on remote computers, particularly Web sites. In accordance with one aspect of the invention, the dissemination and entry of network addresses is accomplished by means of existing identification standards (e.g., bar codes) found on ordinary products like soup or soda, in conjunction with a centralized database of network locations. (col. 3, lines 17-19)

16. The Office Action states that "Russell disclosed a method wherein in response to retrieving the location information, *automatically* connecting the activation system to the remote location (Title, Abstract, column 2 lines 46-67, column 3 lines 1-26)."

The term "retrieving the location" as used by Hudetz and in the context of Russell is different. In Hudetz, "a user enters the product's UPC symbol manually, by swiping a bar code reader over the UPC symbol, or via other suitable input means. The database retrieves the URL corresponding to the UPC code. This location information is then used to access the desired

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resource.” (Abstract). However, in Russell, “[w]hen a code symbol (e.g., magstripe or bar code) encoded with the URL is read using a code symbol reader interfaced with a Java-enabled Internet terminal, the corresponding HTTP document is automatically accessed and displayed at the terminal” (Abstract).

17. The Office Action states that “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combined method of Hudetz and Nelson with the teachings of Russell to include the automatic connection feature in order to allow users to access published locations automatically without manual inputs (Hudetz, column 2 lines 52-67).”

The text of col. 2, lines 52-67, is reproduced below:

In our copending application, we proposed to resolve these problems by allowing people to access published locations without having to manually enter the published address. In accordance with one embodiment of the invention, disclosed in our court pending application the mnemonic address or verbal description of a network location is published along with the location's numeric address in bar code format. The user's computer is equipped with a bar code reader and browser software. The bar code reader is suitably interfaced to the computer's browser software to allow bar code input to be accepted as address information. When the user sees an interesting published address, he scans the associated bar code using the bar code reader, thereby loading the desired numeric address into the browser. The browser then accesses the Web or other site corresponding to that numeric address.

As described before, the Examiner is reciting only a portion of the pertinent text of Hudetz in contravention of MPEP § 2141.02(VI), which requires that a prior art reference must be considered in its entirety. The paragraph of Hudetz (col. 3, lines 1-13) following the above paragraph recites:

We are finding several problems with this and other approaches that have been tried. First, some URLs and other network addresses contain upwards of 20-30 characters, and therefore require very long bar code symbols, which can clutter advertising and packages, and may not be practical from either an esthetic or

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technical perspective. Second, placing URLs on printed material (whether or not in bar code format) requires manufacturers to redesign products, packaging and/or advertisements, and many manufacturers may be reluctant to do this. Third, previous proposal, if the network address is changed, the package needs to be redesigned, and packages already in the marketplace will have incorrect address information.

In other words, Hudetz is teaching away from the publication of a "mnemonic address or verbal description of a network location ... along with the location's numeric address in bar code format." However, Russell is specifically directed to a "System and method for carrying out information-related transactions using web documents embodying transaction enabling applets automatically launched and executed in response to reading URL-encoded symbols pointing thereto." (Title, see also Abstract and numerous references throughout entire patent).

Accordingly, the text of Hudetz directly following that cited by the Examiner actually teaches away from the combination of Russell and Hudetz, and this text must be considered under MPEP § 2141.02(VI). Accordingly, Applicant submits that the preceding language of Hudetz cited in the Office Action in support of the combination of Hudetz and Russell not only fails to suggest such a combination, but actually teaches away from the combination.

33. The Office Action states that "[c]laims 13-15 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hudetz et al. (U.S. Patent Number 5,978,773), hereinafter referred to as Hudetz, in view of Nelson (U.S. Patent Number 6,297,727), in view of Russell et al. (U.S. Patent Number 5,905,248), hereinafter referred to as Russell as applied above, and further in view of Wellner (U.S. Patent Number 5,640,193)."

34. The Office Action states that "[r]egarding claim 13, Hudetz disclosed a method of displaying a web page to a user (Figure 6, column 8 lines 17-20) comprising the steps of retrieving location information associated with the unique code from a database, the location information corresponding to a location of the web page on a remote location disposed on the network (Figure 4, column 9 lines 59-62, column 11 lines 33-60); in response to retrieving the location information, connecting the activation system to the remote location (column 11 lines 28-37); and presenting the web page corresponding to the location information of the remote

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location to the user via the activation system (Figure 6, column 9 lines 54-62). Nelson disclosed a method of providing a portable triggering device having a unique code stored therein (Abstract, column 3 lines 10-13; column 5 lines 42-50) and extracting the unique code from the triggering device with an activation system when the portable triggering device is proximate to the activation system (column 1 lines 40-47, lines 56-61, column 3 lines 10-13, column 6 lines 8-25), the activation system disposed on a network and physically separates from the triggering device (column 3 lines 10-13, column 11 lines 9-12). Russell disclosed a method wherein in response to retrieving the location information, *automatically* connecting the activation system to the remote location (Title, Abstract, column 2 lines 46-67, column 3 lines 1-26)."

As Applicant has previously noted, the term "retrieving the location" as used by Hudetz and in the context of Russell is different. In Hudetz, "a user enters the product's UPC symbol manually, by swiping a bar code reader over the UPC symbol, or via other suitable input means. The database retrieves the URL corresponding to the UPC code. This location information is then used to access the desired resource." (Abstract). However, in Russell, "[w]hen a code symbol (e.g., magstripe or bar code) encoded with the URL is read using a code symbol reader interfaced with a Java-enabled Internet terminal, the corresponding HTTP document is automatically accessed and displayed at the terminal" (Abstract).

35. The Office Action states that "[t]he combination of Hudetz, Nelson, and Russell did not disclose a method wherein the activation system in the step of extracting further includes a unique interface identification code associated with the activation system. However, in an analogous art, Wellner disclosed a method wherein the activation system in the step of extracting further includes a unique interface identification code associated with the activation system (Abstract, column 1 lines 36-42, column 7 lines 3-10)."

As previously noted, Nelson is the only reference relied upon to provide support for an "activation" system. However, the Examiner indicates with the language of paragraph 35 that Wellner discloses an "activation" system by stating that "Wellner disclosed a method wherein the activation system in the step of extracting ...". The Examiner's use of the term "activation" when describing Wellner is not supported in Wellner.

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36. The Office Action states that "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combined teachings of Hudetz and Nelson with the teachings of Richton to include a unique interface identification code in order to allow a user to control the selection of electronic services to be provided to the user by one or more servers over a communication medium (Wellner, column 1 lines 33-36) because this enables the selected electronic service transmitted from the servers to be received by the user's receiver (Wellner, column 1 lines 42-44)."

The text of col. 1, lines 33-36, is reproduced below.

The invention provides an apparatus and method for enabling a user to control the selection of electronic services to be provided to the user by one or more servers over a communication medium.

The text of col. 1, lines 42-44, is reproduced below.

The apparatus then enables the selected electronic service transmitted from the servers to be received by the user's receiver.

Applicant assumes that the reference to Richton is a typographical error and that the reference should be to Wellner. Assuming this is so, it appears that the Examiner is relying on Wellner to provide support for the combination, as no support from either Hudetz or Nelson is provided, and the previously cited text of both Hudetz and Nelson fails to support such a combination as described above. However, the cited text of Wellner simply describes the functionality claimed by the Wellner patent. In other words, the suggestion for the combination cited by the Examiner is simply the functionality provided by Wellner. One skilled in the art would not be motivated to combine Wellner with Hudetz or Nelson based on the cited text of Wellner, because the cited text is describing Wellner itself and one skilled in the art would simply apply Wellner. Accordingly, the Examiner has not identified any support in either Hudetz or Nelson for combining either patent with Wellner, and has only identified text in Wellner that describes Wellner itself, which cannot support the combination as Wellner has no need of either Hudetz or Nelson to support its own described functionality.

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Furthermore, Applicant submits that the Examiner is not identifying a suggestion to combine the references in paragraph 36, but is merely selecting sentences from a reference and stating that it would be obvious to one skilled in the art to make the combination. This is the essence of hindsight reasoning. In other words, the Examiner is not providing support for "why" one skilled in the art would select the components for the claimed combination.

41. The Office Action states that "[c]laims 1-4, 8, 9, 10-11, 16, 18-22, 24, 26, 28-29, 33, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley et al. (U.S. Patent Number 5,903,225), hereinafter referred to as Buckley in view of Schmitt et al. (U.S. Patent Number 5,903,225), hereinafter referred to as Schmitt."

42. The Office Action states that "[r]egarding claims 1 and 19, Buckley disclosed a method and an apparatus for displaying a web page to a user (Figure 9) comprising: a portable device of a user having a unique code stored therein (Figure 1, column 4 lines 49-61, column 5 lines 49-61); and an activation system disposed on a network for extracting the unique code from said device, said activation system physically separate from said device (column 4 lines 49-61, column 5 lines 49-61, column 8 lines 60-column 9 line 7, column 10 lines 32-39); wherein location information associated with said unique code is retrieved from a database, said location information correspond to a location of the web page on a remote location disposed on said network (column 4 lines 62-column 5 lines 8, column 8 lines 60-column 9 line 7); wherein in response to said location information being retrieved from said database, said activation system is automatically connected to said remote location (column 3 lines 3 1-4 1, column 8 lines 60-column 9 line 7); wherein the corresponding web page of said remote location is presented to the user via said activation system (Figure 9, column 8 lines 60-column 9 line 7, column 12 lines 5-14)."

The Examiner indicates with the language of paragraph 42 (citing column 4 lines 49-61, column 5 lines 49-61, column 8 lines 60-column 9 line 7, column 10 lines 32-39) that Buckley includes an "activation" system.

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The text of col. 4, lines 49-61, is reproduced below:

A reader interested in obtaining additional information concerning the subject matter of the article or advertisement utilizes a code reader contained in an instrument such as a pen to read and store a unique code identifying the article. Subsequently, the reader installs the pen in a data well that is designed to receive the unique code from the pen and transmit the code to a computer system.

Alternatively, the pen can communicate directly with the computer. In other words, no physical connection, e.g., no data well, is used. Instead wireless communication technology, such as an infra-red link or other electromagnetic link, is used to allow the pen to communicate directly with a computer.

The text of col. 5, lines 49-61, is reproduced below:

Alternatively, the data reader 16 can communicate directly with a personal computer using wireless communication technology, e.g., a radio-frequency (RF) link, an infrared link, or other electromagnetic link, as described further below. In other words, circuits in the data reader both read the code associated with an article and communicate with a personal computer or other electronic device.

Upon transferring signals representing the scanned code to the computer 28, an application on the computer 28 contacts a company's site on a wide-area network, e.g., on the Internet, corresponding to the scanned code. Furthermore, the scanned code can include instructions to order a particular item or items from the company.

The text of col. 8, line 60 – col. 9, line 7, is reproduced below:

In embodiments of the present invention, the computer 28 is programmed to receive codes from the data well, and upon receiving a code, to access a database contained either within the computer or at a remote location, e.g., using the Internet. In one embodiment, by way of example, a remote database is accessed by the computer through an Internet server using one of a number of known web browsers. The database provides an Internet home page URL address corresponding to the first four characters of the numeric string, and the computer system connects to the internet site corresponding to the URL address using the web browser. At the Internet site, the last four characters of the

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numeric string are used to identify the address of a home page corresponding to the particular article or advertisement or product or stock whose bar code was scanned by the reader.

The text of col. 10, lines 32-39, is reproduced below:

The news agency server 110 implements a common gateway interface (CGI) process to dynamically map between a filtered bar code and a corresponding Uniform Resource Locator (URL). The URL refers to specific articles in content databases 114, 116 and 118. Multiple URLs can be associated with a single bar code. The connection server 108 then relays these URLs from the News Corp Web server 110, through the Internet 106, to the client PC 104.

As is clearly evident, the cited text (column 4 lines 49-61, column 5 lines 49-61, column 8 lines 60-column 9 line 7, column 10 lines 32-39) of Buckley simply refers to a device (e.g., a personal computer) that may interact with a scanning device by receiving data therefrom and fails to disclose any type of "activation" system. Accordingly, Applicant submits that Buckley fails to teach or suggest an "activation" system as required by Applicant's claims.

43. The Office Action states that "Berkley taught the invention substantially as claimed; however, Berkley did not expressly disclose a portable *triggering* device having a unique code stored therein and extracting the unique code from the triggering device with an activation system *when the portable triggering device is proximate to the activation system.*"

44. The Office Action states that "Berkley suggested exploration of art and/or provided a reason to modify the method and apparatus with other features such as wireless and portable triggering device (column 4 lines 56-61, column 5 lines 49-55, column 11 lines 27-37, column 12 lines 52-58)."

The text of col. 4, lines 56-61, is reproduced below:

Alternatively, the pen can communicate directly with the computer. In other words, no physical connection, e.g., no data well, is used. Instead wireless communication technology, such as an infra-red link or other electromagnetic link, is used to allow the pen to communicate directly with a computer.

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The text of col. 5, lines 49-55, is reproduced below:

Alternatively, the data reader 16 can communicate directly with a personal computer using wireless communication technology, e.g., a radio-frequency (RF) link, an infrared link, or other electromagnetic link, as described further below. In other words, circuits in the data reader both read the code associated with an article and communicate with a personal computer or other electronic device.

The text of col. 11, lines 27-37, is reproduced below:

In embodiments of the present invention described above, a code reader is incorporated into a pen. In other embodiments, the code reader may be incorporated in other writing instruments, or may be incorporated in some other, preferably portable, device such as a watch, cellular phone, etc. In still other embodiments, the code reader may be a stand-alone portable device designed to easily fit within a pocket or brief case and may be even incorporated into a laser-pointer-type shaped device which may be attached to a user's keychain.

The text of col. 12, lines 52-58, is reproduced below:

Having thus described at least one illustrative embodiment of the invention, various alterations, modifications and improvements will readily occur to those skilled in the art. Such alterations, modifications and improvements are intended to be within the scope and spirit of the invention. Accordingly, the foregoing description is by way of example only and is not intended as limiting.

Applicant submits that the examples provided by the above text of Buckley do not provide a suggestion for combining Buckley with Schmitt or any reference, but merely provide for variations of the scanner of Buckley (e.g., alternative embodiments of Buckley itself). Furthermore, Applicant submits that a laundry list of possible variations, including the boilerplate text of col. 12, lines 52-58, clearly do not provide a suggestion for making a selective combination based on the current references. Again, as the Federal Circuit required in *Cardiac Pacemakers*, "[w]hen prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself." Here, the Examiner has not identified any

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real suggestion for the combination of Buckley and Schmitt, and instead has simply identified various portions of Buckley that identify alternate embodiments. For example, nowhere in the cited text can Applicant find any teaching or suggestion of selectively combining Buckley with a "portable triggering device" as required by the Federal Circuit.

45. The Office Action states that "[i]n an analogous art, Schmitt disclosed a portable triggering device [passive transponder] of a user having a unique code stored therein (Abstract, Figure 14, column 2 lines 51-60), which is activated when the portable triggering device is proximate to the activation system (column 3 lines 7-18, lines 53-57, column 12 lines 47-59, column 13 lines 3-15, column 14 lines 26-36)."

46. The Office Action states that "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method and apparatus of Berkley with the teachings of Schmitt to include a portable triggering device of a user having a unique code stored therein in order to eliminate the cumbersome scanner because the triggering device would communicate with the activation system automatically when the user is in contact with the activation system (Schmitt, column 12 lines 4-55). In addition, the portable triggering device would prevent the users through the inconvenience of locating and manipulating the reader or scanner system (Schmitt, column 2 line 61-column 3 line 3)."

Lines 47-55 of the cited text of Schmitt (col. 12, lines 4-55) are reproduced below.

The authorized person 225 bearing the access card 207 may unobtrusively be granted access merely by approaching the access location. The access triggering device or badge 207 will communicate with the access controller 210 and grant access as long as the device bearer is sufficiently close to the access location 230. In other words, the authorized person 225 need not go through the inconvenience of manipulating a card in contact with a card reader, for example.

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Col. 2, line 61 – col. 3, line 3 are produced below.

The authorized person bearing the access trigger device may unobtrusively be granted access merely by approaching the access location. The access triggering device will communicate with the access control means and grant access as long as the device bearer is sufficiently close to the access location. In other words, the authorized person need not go through the inconvenience of locating and manipulating a card for swiping through a card reader, for example. In addition, the person preferably need not stop for another fingerprinting step at the access location. Moreover, a high degree of security is provided since the person is originally enrolled based upon the positive identification afforded by fingerprint sensing.

The cited text of the Schmitt reference simply identifies a problem for which Schmitt itself provides a solution. This is not a suggestion to combine the reference with another reference, but is merely describing a benefit provided by the reference itself. Furthermore, the identification of a problem is not dispositive of a suggestion or motivation for a combination. With respect to this issue, the Federal Circuit has stated that “the nature of the problem to be solved may, under appropriate circumstances, provide a suggestion or motivation to combine prior art references. However, the test requires that the nature of the problem to be solved be such that it would have led a person of ordinary skill in the art to combine the prior art teachings in the particular manner claimed.... We have recognized this situation when two prior art references address the precise problem that the patentee was trying to solve.” (emphasis added). Teleflex at 288. Not only do Buckley and Schmitt contain solutions to their own identified problems and therefore provide no motivation for a combination, but the problems they identify are certainly not the precise problem faced by the Applicant.

57. The Office Action states that “Applicants’ arguments in Amendment, filed 07/07/2005 with respect to the pending claims 1-16, 13-33, and 35 have been considered but are not persuasive.”

58. The Office Action states that “[i]n response to applicant’s argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed

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invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner had established a proper combination of Hudetz, Nelson, and Russell by providing detailed reasons for exploration of art, suggestion or motivation to combine, and reasons for combining. For instance, Hudetz disclosed, 'The foregoing embodiment is just one example. Many alternatives are possible. For example, in lieu of a bar code scanning device, a card reader could be employed. The card reader would read a magnetic stripe affixed to a card or other printed matter. The card would contain human-readable information about a network resource, and the magnetic strip would contain the resource's numeric or mnemonic address in machine-readable format' (column 12 lines 11-17). Please refer to the above rejection for details."

Applicant has addressed the Examiner's detailed reasons at length in the present Response. However, Applicant notes that the cited text of Hudetz (col. 12, lines 11-17) simply identifies that alternate embodiments are available and then states that a "card would contain human-readable information about a network resource, and the magnetic strip would contain the resource's numeric or mnemonic address in machine-readable format." As Applicant has discussed at length in the present Response, this fails to meet the burden for showing a suggestion or motivation to combine.

59. The Office Action states that "[a]s the rejection reads, Examiner asserts that the combination of these teachings render the claimed invention obvious."

60. The Office Action states that "[r]egarding the Buckley and Schmitt references, Applicant's arguments filed 07/07/2005 have been fully considered but they are not persuasive."

61. The Office Action states that "[i]n response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed

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invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as detailed in the rejection above, Berkley suggested exploration of art and/or provided a reason to modify the method and apparatus with other features such as wireless and portable triggering device (column 4 lines 56-61, column 5 lines 49-55, column 11 lines 27-37, column 12 lines 52-58). One of ordinary skill in the art at the time of the invention was made would have been motivated to modify the method and apparatus of Berkley with the teachings of Schmitt to include a portable triggering device of a user having a unique code stored therein in order to eliminate the cumbersome scanner because the triggering device would communicate with the activation system automatically when the user is in contact with the activation system (Schmitt, column 12 lines 4-55). In addition, the portable triggering device would prevent the users through the inconvenience of locating and manipulating the reader or scanner system (Schmitt, column 2 line 61-column 3 line 3). Since the Examiner had properly provided some teaching, suggestion, or motivation to combine the two references, the combination of Buckley and Schmitt is valid."

Applicant has addressed the Examiner's detailed reasons at length in the present Response and Applicant's comments are not repeated with respect to this paragraph.

62. The Office Action states that "[a]s the rejection reads, Examiner asserts that the combination of these teachings render the claimed invention obvious."

Conclusion

Basically, the Examiner is taking a system that scans a standardized product code (e.g., a UPC) and links the code with a web page based on a person's or a computer's selection using an HTML document (Hudetz). He is then combining Hudetz with a transponder that contains a transponder code used for identification purposes (Nelson), even though such a code has no relationship to a product code and even though the transponder has absolutely nothing to do with web pages. A further combination is then made with a device that uses an encoded URL to automatically connect to a web page (Russell) so that the combination of Hudetz and Nelson

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can automatically connect to a web page. In order for this combination to render obvious Applicant's claimed invention, one skilled in the art would have to select particular component parts of Hudetz (e.g., scanning in a product code having no routing information embedded therein and linking the code to a web page), then select particular components of Nelson (e.g., a transponder and its associated personnel ID code which has no routing functionality associated therewith), then select particular components of Russell (e.g., automatically connecting to a web page based on an encoded URL on a product where the encoded URL comprises the routing information), and then integrate these components in the particular manner required for Applicant's invention. For the integration to work correctly, one skilled in the art would apparently, for some unexplained reason, select a code that equates to Applicant's code from the UPC type code of Hudetz, the ID code of Nelson, and the encoded URL of Russell, decide to integrate this code with the transponder of Nelson, and then selectively combine various aspects of the systems of Hudetz, Nelson, and Russell to place the code into the transponder, extract the code from the transponder, associate the code with a network location, and automatically direct a user to a web page associated with the network location without user intervention. As Applicant has explained in detail above, Applicant submits that the Examiner has failed to meet the burden imposed by both the MPEP and 35 U.S.C. § 103 for such a combination.

In summary, Applicant submits that the text cited by the Examiner from the various references fails to provide a suggestion or motivation for the various combinations because the text fails to illustrate "why" one skilled in the art would combine the references in the particular manner required. Instead, the text simply identifies particular components for each reference, combines them in a specific manner required by Applicant's claimed invention, and then states that it would be obvious to one skilled in the art to do so. This is clearly hindsight based reasoning that contravenes the standards imposed by both the MPEP and the Federal Circuit, and Applicant respectfully submits that the cited combinations are improper for reasons detailed above and requests that the rejections under § 103 be withdrawn.

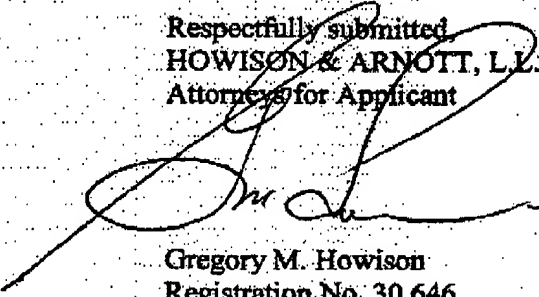
Applicant has now made an earnest attempt in order to place this case in condition for allowance. For the reasons stated above, Applicant respectfully requests full allowance of the

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claims as amended. Please charge any additional fees or deficiencies in fees or credit any overpayment to Deposit Account No. 20-0780/PHLY-25,356 of HOWISON & ARNOTT, L.L.P.

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